

REMARKS

Applicant has carefully reviewed the Office Action dated June 24, 2009. Applicant has amended Claims 1 and 9 to more clearly point out the present inventive concept. New Claim 25 has been added. Reconsideration and favorable action is respectfully requested.

Regarding Claims Rejections – 35 U.S.C. § 102

Claims 1-2 and 4-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2001/0013542 A1 to *Horowitz et al.* (hereinafter “*Horowitz*”). This rejection is respectfully traversed.

Independent Claim 1 as amended includes the feature of “at a user location disposed on the network, resolving a machine-resolvable code (MRC) having a representation of the coded information contained therein and disposed on the credit card of the user, the representation of the coded information having no personal information contained therein relating to the user and no routing information over a network” (emphasis added). Applicant respectfully submits that *Horowitz* fails to teach or suggest at least this feature of Claim 1 as amended. In the Response to Arguments on page 15, the Office Action indicates that the “machine-readable code (MRC) is interpreted to be the information read by an ATM from the transaction card, specifically the special transaction number and the bank routing number” as described in paragraph [0028] of *Horowitz*. As acknowledged in the Office Action, the bank routing number of *Horowitz* is stored in the magnetic stripe memory 42 of transaction card 32 and is thus stored within the transaction card 32 as well as contained within what is asserted by the Office Action to be the “MRC” of *Horowitz*. In contrast to the system of *Horowitz* in which magnetic stripe memory 42 of transaction card 32 stores a bank routing number which is obtained from the transaction card 32 during an ATM reading operation, the “MRC” of Claim 1 contains no such “routing information” and the “routing information” is not stored on the “credit card.”

Further regarding Independent Claim 1, the Office Action asserts on page 3 that paragraphs [0024] and [0025] of *Horowitz* disclose “using the transmitted representation of the coded information at the specific and unique credit card company server to determine the

personal account information associated with the extracted representation of the coded information” and “returning the determined personal account information from the specific and unique credit card company server to the user location.” Applicant respectfully disagrees. All paragraph [0024] of *Horowitz* specifies is that the special account number be recognized by the bank as a special account with the use of a special indicator. Paragraph [0025] of *Horowitz* merely provides a terminal that can read and write to the magnetic stripe memory and possibly to the advanced technology memory (44). There is nothing in these two paragraphs that indicates that the transmitted coded information, i.e., the account information according to the Examiner, is also used to determine personal account information. Further, there is no teaching in *Horowitz* that personal account information is then returned from the credit card company server to the user location after being determined by the same code used to determine the routing information to the bank. The Examiner refers to paragraph [0024] and [0025] for this step. The special transaction number is in no way utilized in paragraph [0025]. This paragraph refers to the ability to transfer funds from the host system to the card. This does not involve any of the special coding features. It is just a way for a user to use some type of system to access or interface with the host system.

In contrast to the system of *Horowitz*, Claim 1 describes that a representation of coded information is extracted from the MRC and the “routing information to the credit card server associated with the extracted representation of the coded information” as well as “personal account information associated with the extracted representation of the coded information” is obtained utilizing the extracted representation of the coded information, but is not contained within the MRC itself. *Horowitz* contains no teaching or suggestion of resolving an MRC to extract a representation of coded information and using the extracted representation of coded information to *both* obtain routing information to a credit card server associated with the extracted representation of coded information, as well as using the extracted representation of coded information to determine personal account information associated with the extracted representation of coded information. Similar features are found in independent Claim 9. Therefore, for at least the foregoing reasons, Applicant submits that *Horowitz* does not disclose each and every element and each and every step in Claims 1 and 9 and, therefore, respectfully requests withdrawal of the 35 U.S.C. § 102 rejection with respect to Claims 1-2 and 4-11.

Regarding Claims Rejections – 35 U.S.C. § 103

Claims 3 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Horowitz et al.* in view of *Perkowski*. This rejection is respectfully traversed.

To support the rejection of Claims 3 and 12, the Examiner relies on the combination of *Horowitz* and *Perkowski* and *Perkowski*, but Applicant contends that these references, either taken singularly or in combination, do not cure the deficiencies noted hereinabove with respect to Claim 1. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection with respect to Claims 3 and 12.

Claims 1-5 and 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 20020016749 to *Borecki et al.* (hereinafter “*Borecki*”) in view of U.S. Patent No. 6,064,979 to *Perkowski* (hereinafter “*Perkowski*”). This rejection is respectfully traversed.

On page 8 of the Office Action the Examiner states:

As to claim 1, Borecki teaches the invention substantially as claimed. Borecki teaches a system and method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:

connecting a user location to the specific and unique credit card company server across the network in accordance with a known URL (Borecki, Figure 2A and page 2, paragraph 0034-0035);

transmitting the account information to the specific and unique credit card company server over the network (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039);

using customer account information at the specific and unique credit card company server to determine the personal account information associated with the customer account information from the credit card company server, to the user location (Borecki, page 3, paragraph 0040); and

presenting the information to the user at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).

The Examiner further states that “. . . Borecki does not explicitly teach automating the steps of accessing said credit card company server,” and then provides *Perkowski* to cure the

deficiency and states “it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the automated data entry and data locating system of Perkowski, into the system of Borecki, for the predictable result of applying known techniques of automated data entry and distributed data computing to the system.” The Office Action further asserts that “the distributed nature allows enhancements in flexibility, security, scalability, and redundancy of the networked system.”

Applicant respectfully disagrees that the cited combination of *Borecki-Perkowski* teaches the claimed features of independent Claim 1. Appellants submit that *Borecki* does not disclose, or contemplate, resolving an MRC to extract coded information associated with routing information that is associated with *both* the personal account information of the user and a specific and unique credit card company server. The Examiner concedes on page 9 of the Office Action that the primary citation to *Borecki* does not disclose “at a user location disposed on the network, resolving a machine-resolvable code (MRC) having a representation of the coded information contained therein and disposed on the credit card of the user...”, “extracting the representation of the coded information from the MRC, the representation of the coded information associated with routing information that is associated with both the personal account information of the user and a specific and unique credit card company server...”, “in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted representation of the coded information...”, and “connecting the user location to the specific and unique credit card company server across the network over a determined route in accordance with the obtained routing information...”. Nonetheless, the Examiner rejects Independent Claim 1 stating that “*Borecki* teaches the invention substantially as claimed” and contending that the secondary citation to *Perkowski* provides this necessary disclosure. This contention is respectfully traversed as discussed with respect to the combination of *Borecki* and *Perkowski* herein below.

Borecki relates to a system for electronic purchasing over the Internet by a user through the use of a digital checkbook. *Borecki* contains no teaching or suggestion of resolving an MRC to extract a representation of coded information and using the extracted representation of coded information to both obtain routing information to a credit card server associated with the

extracted representation of coded information, as well as using the extracted representation of coded information to determine personal account information associated with the extracted representation of coded information. *Perkowski* also fails to teach or suggest such features. *Perkowski* provides a method and system for finding and serving consumer product-related information on the Internet. *Perkowski* is directed towards the concept of providing an interface to a user to allow that user to search information regarding either a product having an associated Universal Product Code (UPC) or Universal Product Number (UPN) or information regarding products associated with the trademark. The Office Action refers to column 19, lines 12-55 of *Perkowski* to cure these deficiencies of *Borecki*. The cited portion of *Perkowski* describes scanning a UPC to merely enter a 12 digit number into a browser. Further, as a result of the user selecting the IPSI Finder button and entering the UPC, the user makes a request of the Internet Product and Service Directory (IPSD) server to query the IPSI Registrant Database to determine if a URL has been registered with the UPC that has been entered. If the IPSD server finds a registered URL containing the UPC, the URL, or a list of URLs if more than one URL is registered with the UPC, is returned to the user. As such, routing information is returned, not in response to resolving and extracting, but in response to the user initiating a request for the URL. Further, *Perkowski* teaches that the user establishes a connection to the location containing product information. Accordingly, *Perkowski* teaches, and is limited to teaching, entering a UPC number, either manually or by scanning operation, to obtain a URL that the user may select in order to access a website containing information about a product related to the UPC. *Perkowski* contains no teaching or suggestion that the UPC is used to obtain personal account information in addition to routing information. Accordingly neither *Borecki* nor *Perkowski*, either alone or in combination, contains any teaching or suggestion of resolving an MRC to extract a representation of coded information and using the extracted representation of coded information to both obtain routing information to a credit card server associated with the extracted representation of coded information, as well as using the extracted representation of coded information to determine personal account information associated with the extracted representation of coded information as found in Claim 1.

Further, even if the cited *Borecki-Perkowski* taught the features of Claim 1, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in

order to combine the *Borecki* and *Perkowski* references. Appellants submit the Examiner has simply broken Appellants' invention into its component parts and then attempted to find a prior art reference corresponding to each component to support an obviousness rejection under 35 U.S.C. § 103. As discussed in MPEP § 2141, in order to establish a *prima facie* case of obviousness using the combination of the respective references, the Examiner must first show that each of the references is analogous prior art and then provide an explanation as to whether the overall disclosures of the references, the teachings therein and the suggestions associated therewith, in addition to the level of skill in the art, support a conclusion of obviousness as it relates to the entire invention. Applicants respectfully submit that the combination of these references as applied to the Claims is conclusory, and that no articulated reasoning with some rational underpinning to support the combination has been provided. For example, the cited portion of the MPEP states that "any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." applicants submit that the Examiner has failed to do so. ." The Examiner indicates that it would have been obvious to combine the two in order to improve the *Perkowski* system "for the predictable result of applying known techniques of automated data entry and distributed data computing to the system" and that "the distributed nature allows enhancement in flexibility, security, scalability and redundancy of the networked system." Applicant respectfully submits that the Examiner has provided no support for such allegation. The Examiner has not provided any indication why one skilled in the art would find this to be a predictable result, the level of skill required in the art or any detail as to why such is the case other than just a mere broad ranging statement. Applicant believes that this is insufficient and the Examiner has not met the burden of proof of providing a *prima facie* case for such a conclusion. Further, Appellants submit that support for the combination is based on hindsight and that the combination is improper. In view of the foregoing, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection with respect to Claims 1-5 and 7-12.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Borecki-Perkowski* and further in view of *Brook et al.* This rejection is respectfully traversed.

To support the rejection of Claim 6, the Examiner relies on the combination of *Borecki* and *Perkowski* made with respect to Claim 1. Applicant submits that *Brook* does not cure the aforementioned deficiencies of *Borecki* and *Perkowski* with respect to Claim 1. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection with respect to Claim 6.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/RPXC-25,338 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,
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